

ATTORNEY DOCKET NO.
13647.0003

PATENT
Customer ID No. 33649

REMARKS/ARGUMENTS

Claims 1-4 and 7-22 are pending. In an Office Action dated 4/27/2005, claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Sandahl. Claims 2 and 7-9 were rejected over 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Sandahl and further in view of Resende. Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Sandahl and further in view of ANN (IEE OPOS (USPOS)* Compatible Pole Display Software). Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Sandahl and further in view of Rogge. Claims 10, 14 and 17 were rejected under 35 U.S.C. 102(e) as being anticipated by Ciccone. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Sandahl. Claim 13 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Rogge. Claims 15, 16, 18 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Resende. Claims 19 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Coutts. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone, presumably in view of Resende (this is not clear in the office action), and presumably further in view of alleged admitted prior art.

The Applicants appreciate the Examiner's reconsideration of the final rejection of the claims, and further note that the Examiner has apparently taken great pains to avoid further piecemeal prosecution per the admonishment in M.P.E.P. 707.07(g) by citing various combinations of six pieces of prior art in 10 different combinations. It is the Applicants' sincere hope that after successfully traversing these rejections, the claims will be allowed and that new art will not be again cited against these claims.

The Applicants will address the rejection of the claims in the order presented by the Examiner, with the exception of claim 22, which will be addressed first in the hopes that the Examiner will give these arguments emphasized consideration.

Claim 22

Claim 22 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Resende. In particular, the Examiner states that Resende teaches "a change in business

ATTORNEY DOCKET NO.
13647.0003

PATENT
Customer ID No. 33649

entity (the modification of merchandise inventories, col. 5, ln. 50-67), determining (predetermined, col. 6, ln. 1-10), modify of the template (the modification o merchandise inventories contained in each of the various sales points, col. 6, ln 1-10), a telephone number, a list of allowable cards, a merchant number, an address, program modules, disabling program, enabling loyalty, disabling loyalty cart, enabling frequent buyer (sales, profit margins, etc, col 5, ln 53-67/a telephone, a cordless telephone, a backup power supply, a notebook computer...., col. 6, ln 36-67)." This rejection is respectfully traversed.

The terms addressed by the Examiner are only addressed in isolation; claim 22 is a method claim, and the mere disclosure of structure that is capable of performing the claimed steps without the disclosure of the claimed steps themselves is not sufficient to anticipate a method claim. This was clearly decided by the Federal Circuit a decade ago, when they stated in no uncertain terms that a general purpose computer does not anticipate the millions of special purpose computers that can be realized by programming such a general purpose computer. However, even if that were enough, *much of the structure that Resende allegedly discloses is simply not present!* Furthermore, a number of the claim elements are not even addressed. The Applicants will address each of these limitations as best as possible.

1. "a change in business entity (the modification of merchandise inventories, col. 5, ln. 50-67)." This appears to relate to the following element of claim 22: "determining that a change in a business entity has occurred for a point of sale device." However, the cited section of Resende fails to disclose this step, even if one assumes that "modification of merchandise inventories" is "a change in business entity." The following is disclosed by Resende at col. 5, lines 50-67:

instance, to assist the agent in conducting transactions with customers. As depicted in block 50, such transactions may be remotely monitored, such as by the control center through the use of video imaging, for instance. The remote monitoring of transactions also preferably includes receiving a transaction report from each of the various sales points 12, as depicted in block 52, which may include information regarding balance of sales at the end of the day, inventory, pricing, marketing, etc. Once received from the sales points 12, *the transaction reports may be utilized by the control center* for reevaluating market strategy, such as for improving sales, improving profit margins, etc. Such market strategies may, for instance, be developed by the admin/marketing department and may include recommendations regarding the repositioning of sales points, and/or the

ATTORNEY DOCKET NO.
13647.0003

PATENT
Customer ID No. 33649

modification of merchandise inventories contained within each of the various sales points, among others. Additionally, sales point transactions reports,

(emphasis added). Where, in the cited passage is "determining that a change in a business entity has occurred for a point of sale device" in regards to a "method for programming point of sale devices" disclosed? Even with the broad construction adopted by the Examiner that apparently a "change in business entity has occurred for a point of sale device" is a "modification of merchandise inventories," that construction is based on the assumption that it is the *point of sale device* that has the *relationship* with the *business entity*! Clearly, to the extent that a modification of merchandise inventories is a change in a business entity, that change in business entity is not for a point of sale device but for the entity that owns the point of sale device and operates the control center. The step of "determining that a change in a business entity has occurred for a point of sale device" in regards to a "method for programming point of sale devices" is simply not disclosed – at best, the cited section of Resende relates to determining whether to change inventory in a display, but has nothing to do with determining that a change in business entity has occurred for a point of sale device in regards to a method for programming point of sale devices.

2. "determining (predetermined, col. 6, ln. 1-10)." Apparently, the Examiner relies on the recitation of "predetermined" at col. 6, lines 1-10 of Resende as a basis for each of the 13 "determining" steps of claim 22. However, not only is "predetermined" not the same thing as "determining" in a method for programming point of sale devices, there has not been any attempt to relate the disclosure at col. 6, lines 1-10 of Resende to each of the 13 determining steps of claim 22. The cited section of Resende states "the transport of merchandise based on inventory may include replenishing each sales point to a predetermined inventory of merchandise based upon sales of the individual sales points" The only thing that is "predetermined" is the inventory of merchandise for a display cabinet. Thus, Resende merely discloses that the control center determines the level of inventory associated with a display cabinet. This has nothing to do with any of the 13 determining steps of claim 22 in relation to a method for programming point of sale devices.

3. "modify of the template (the modification of merchandise inventories contained in each of the various sales points, col. 6, ln 1-10)." The word "template" is not even used in

ATTORNEY DOCKET NO.
13647.0003

PATENT
Customer ID No. 33649

Resende. Furthermore, claim 22 does not claim "modify of the template" – the corresponding elements of claim 22 that is apparently being referred to are the 9 steps that follow the step of "selecting a template for the point of sale device." The step of selecting a template for the point of sale device is not disclosed in Resende! Since all of the template modification steps occur after a template has been selected, the subsequent steps relating to modification of the template simply cannot be disclosed by Resende. In fact, using the asserted construction "modify of the template (the modification of merchandise inventories contained in each of the various sales points, col. 6, ln 1-10)," the "template" *must be the merchandise inventories*. This construction renders all of the subsequent steps for determining whether to modify the template untenable – are telephone numbers merchandise inventory? Are allowable cards merchandise inventory? Are merchant numbers, program modules, or loyalty card programs merchandise inventories? Clearly not – and nothing could more clearly demonstrate the impropriety of the rejection of claim 22 over Resende.

4. "a telephone number," citing to "(sales, profit margins, etc, col 5, ln 53-67/a telephone, a cordless telephone, a backup power supply, a notebook computer...., col. 6, ln 36-67)." Again, claim 22 does not claim "a telephone number," but rather "determining whether to modify the template to include changing a telephone number for the point of sale device based on the change in business entity." The mere assertion that Resende anticipates the claim element "determining whether to modify the template to include changing a telephone number for the point of sale device based on the change in business entity" because it includes the term "telephone number" is insufficient to comply with the requirements of MPEP 706.02(j) and 707.07. Furthermore, review of the cited section reveals that the term "telephone number" is *not even disclosed*.

5. "a list of allowable cards," citing to "(sales, profit margins, etc, col 5, ln 53-67/a telephone, a cordless telephone, a backup power supply, a notebook computer...., col. 6, ln 36-67)." This apparently refers to the claim element "determining whether to modify the template to include changing a list of allowable cards based on the change in business entity." However, just like the previous element, the cited section does not even contain the term "list of allowable card," much less anything remotely related to a list of allowable cards – in fact, the term "allowable cards" is not even used anywhere in Resende.

ATTORNEY DOCKET NO.
13647.0003

PATENT
Customer ID No. 33649

6. "a merchant number," citing to "(sales, profit margins, etc, col 5, ln 53-67/a telephone, a cordless telephone, a backup power supply, a notebook computer...., col. 6, ln 36-67)." This apparently refers to the step of "determining whether to modify the template to include changing a merchant number based on the change in business entity." However, just like the previous elements, the cited section does not even contain the term "merchant number," much less anything remotely related to a merchant number – in fact, the term "merchant number" is not even used anywhere in Resende.

7. "an address," citing to "(sales, profit margins, etc, col 5, ln 53-67/a telephone, a cordless telephone, a backup power supply, a notebook computer...., col. 6, ln 36-67)." This apparently refers to the step of "determining whether to modify the template to include changing an address based on the change in business entity." However, just like the previous elements, the cited section does not even contain the term "address," much less anything remotely related to an address – in fact, the term "address" is not even used as a noun anywhere in Resende.

8. "program modules," citing to "(sales, profit margins, etc, col 5, ln 53-67/a telephone, a cordless telephone, a backup power supply, a notebook computer...., col. 6, ln 36-67)." This apparently relates to the step of "determining whether to modify the template to include enabling program modules based on the change in business entity." However, just like the previous elements, the cited section does not even contain the term "program modules," much less anything remotely related to a program module – in fact, the term "program module" is not even used anywhere in Resende.

9. "disabling program," citing to "(sales, profit margins, etc, col 5, ln 53-67/a telephone, a cordless telephone, a backup power supply, a notebook computer...., col. 6, ln 36-67)." This apparently relates to the step of "determining whether to modify the template to include disabling program modules based on the change in business entity." However, just like the previous elements, the cited section does not even contain the term "disabling program," much less anything remotely related to disabling a program – in fact, the term "disabling" is only used in Resende in regards to "disabling the hinges" of the display case, see col. 12, line 6.

10. "enabling loyalty," citing to "(sales, profit margins, etc, col 5, ln 53-67/a telephone, a cordless telephone, a backup power supply, a notebook computer...., col. 6, ln 36-67)." This apparently relates to the step of "determining whether to modify the template to

ATTORNEY DOCKET NO.
13647.0003

PATENT
Customer ID No. 33649

include enabling loyalty card programs based on the change in business entity." However, just like the previous elements, the cited section does not even contain the term "loyalty," much less anything remotely related to a loyalty card – in fact, the term "loyalty " is not even used anywhere in Resende.

11. "disabling loyalty cart," citing to "(sales, profit margins, etc, col 5, ln 53-67/a telephone, a cordless telephone, a backup power supply, a notebook computer...., col. 6, ln 36-67)." The Examiner no doubt means to refer to "card" instead of "cart," and is apparently referring to the step of "determining whether to modify the template to include disabling loyalty card programs based on the change in business entity." As previously discussed, Resende entirely fails to provide a basis for rejection of this element.

12. "enabling frequent buyer," citing to "(sales, profit margins, etc, col 5, ln 53-67/a telephone, a cordless telephone, a backup power supply, a notebook computer...., col. 6, ln 36-67)." Apparently this relates to the step of "determining whether to modify the template to include enabling frequent buyer card features based on the change in business entity." However, just like the previous elements, the cited section does not even contain the terms "frequent" of "buyer," much less anything remotely related to a frequent buyer – in fact, neither of the terms "frequent" and "buyer" are even used anywhere in Resende.

It is further noted that the Examiner entirely failed to address the steps of "determining whether to modify the template to include disabling frequent buyer card features based on the change in business entity; determining whether to modify the template to include modifying authorization host features in response to call swipes based on the change in business entity; and determining whether to modify the template to include modifying credit card reversal of transaction features based on the change in business entity."

It has thus been shown that Resende simply fails to disclose many of the elements of claim 22, and no attempt was even made to show where Resende discloses a number of the elements of claim 22. It is sincerely hoped that the rejection of claim 22 will be withdrawn, as this is the third office action in which Resende has been used as a basis for the rejection of this claim, it has been clearly demonstrated that Resende fails to disclose any of the elements of this claim, the Examiner did not even attempt to point out where 4 of the claim elements of claim 22 are disclosed in Resende or Ciccone, and hopefully the Examiner has thoroughly searched the

ATTORNEY DOCKET NO.
13647.0003

PATENT
Customer ID No. 33649

prior art after issuing 4 office actions for this case and will not be inclined to cite yet another piece of prior art against this claim, such as by using the claim as a roadmap for finding a combination of art.

Claims Other than Claim 22

Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Sandahl. In particular, it is acknowledged that Ciccone does not teach the initiation of the device update by the device itself, but it is alleged that Sandahl discloses this limitation. This rejection is respectfully traversed.

Ciccone in view of Sandahl fails to anticipate claim 1 under 35 U.S.C. 103(a), as they fail to disclose each element of the claimed invention. While the Examiner is correct that Ciccone discloses computing functionality that could arguably be equivalent to a point-of-sale terminal, Sandahl fails to disclose such computing functionality, and it is the functionality of Sandahl that allegedly provides what is admitted to be missing from Ciccone by the Examiner – "update requests from the plurality of devices." The devices of Sandahl are not point-of-sale terminals, they are PCs. This is emphasized by Figure 4, the discussion of which includes the section cited by the Examiner. In that cited section, it relates that the managed devices of Sandahl receive related file information and compare that related file information to a local file. A point-of-sale terminal lacks the programming power to perform such a comparison.

Nevertheless, in an effort to avoid the continued rejection of the claims over art that fails to disclose the claim limitations, Claim 1 and the claims that depend therefrom have been amended to recite means plus function limitations. The Applicants call the Examiner's attention to the Federal Circuit's guidance in *WMS Gaming, Inc. v. Int'l Game Technology*, 184 F.3d 1339, 1349 (Fed. Cir. 1999), which holds that:

In a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.

As such, the Examiner must comply with controlling Federal Circuit precedent and identify the corresponding algorithm in the cited references if the rejection of claim 1 and the claims that depend therefrom is to be maintained over the cited art. As the cited art fails to disclose the

ATTORNEY DOCKET NO.
13647.0003

PATENT
Customer ID No. 33649

corresponding structure of the means plus function elements of claim 1, withdrawal of this rejection is respectfully requested.

Claims 2 and 7-9 were rejected over 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Sandahl and further in view of Resende. While the Applicants maintain their position that the characterization of the teachings of Resende is improper, as discussed at length above, these claims have been amended to recite means plus function limitations. Accordingly, the Examiner must identify where the cited references disclose the corresponding structure or withdraw the rejection of these claims.

Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Sandahl and further in view of ANN (IEE OPOS (USPOS)* Compatible Pole Display Software). While the Applicants maintain their position that the characterization of the teachings of ANN (IEE OPOS (USPOS)* Compatible Pole Display Software) is improper, as discussed at length in response to previous office actions, this claim has been amended to recite means plus function limitations. Accordingly, the Examiner must identify where the cited references disclose the corresponding structure or withdraw the rejection of these claims.

Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Sandahl and further in view of Rogge. While the Applicants maintain their position that the characterization of the teachings of Rogge is improper, as discussed at length in response to previous office actions, this claim has been amended to recite means plus function limitations. Accordingly, the Examiner must identify where the cited references disclose the corresponding structure or withdraw the rejection of these claims.

Claims 10, 14 and 17 were rejected under 35 U.S.C. 102(e) as being anticipated by Ciccone.

Claim 10 includes a "method for programming point of sale devices comprising: receiving a programming request for a point of sale device; determining which of two or more proprietary operating systems is used by the point of sale device; and transmitting the programming request to the point of sale device based on the proprietary operating system used by the point of sale device." The Examiner cites to various sections of Ciccone as a basis for asserting that it discloses "determining which of two or more proprietary operating systems is used by the point of sale device," and these will be considered individually.

ATTORNEY DOCKET NO.
13647.0003

PATENT
Customer ID No. 33649

1. Col. 12, line 6 – this citation is to a single term in a sentence that reads as follows: "In particular, a user may specify that: (1) only certain products are tested, with the default being to test all products that have been installed on the selected node 110; (2) only certain object types (e.g., (a) file names and links, (b) required process names, (c) license servers, (d) replaceable file mount/attach/map, (e) data quotas, (f) time synchronization, (g) network servers, (h) runaway processes, (i) time limited processes, (j) hardware configuration, (k) operating system configuration, (l) network binding, (m) node CPU availability/Xterm availability, and/or (n) disk capacity) are tested, with the default being all types except CRC testing (and security on NT systems); and (3) file CRC testing is to be bypassed, which is the default and improves performance significantly, but is less rigorous." (Emphasis added). However, merely allowing a user to specify an operating system configuration is not "determining which of two or more proprietary operating systems is used by the point of sale device." A single operating system may have many different configurations – there is no disclosure in this cited section that supports equating "determining which of two or more proprietary operating systems is used by the point of sale device" with "operating system configuration."

2. Col. 2, lines 27-37. This citation states: "Referring to FIG. 1, a change monitoring system 2 for a computer system 4 is illustrated. The computer system 4 has a plurality of platforms (shown as monitored nodes) 6,8 and a plurality of products, such as the exemplary software products 10,12,14,16. The exemplary platform 6 employs a first operating system (O1) 18, such as Unix, and the exemplary platform 8 employs a second operating system (O2) 20, such as Windows NT, which is different than the first operating system 18, although a wide range of operating systems (e.g., Windows 95, Windows 98), which may be the same or different in each of the platforms, may be employed." While this does in fact recite that different operating systems are contemplated for use with the invention of Ciccone, it also fails to disclose "determining which of two or more proprietary operating systems is used by the point of sale device."

3. Col. 5, lines 15-65. As this section is too long to block quote, it is necessary to sift through it to try and determine what is relevant. Although the section does refer to operating systems, it also states that "Each unique set of hardware and operating system is an individual

ATTORNEY DOCKET NO.
13647.0003

PATENT
Customer ID No. 33649

platform," and it further adds that "The platforms . . . have a set of product templates for the products. . . ." Thus, Ciccone does not disclose "determining which of two or more proprietary operating systems is used by the point of sale device," but rather determining the identity of a unique platform. All decisions in Ciccone are made based on the template associated with each platform, as "templates 28, 30 provide file management control." It is important to note that only a single template 34 provides hardware control for all platforms, whereas two file management control templates are provided for the two exemplary platforms 6, 8 of Ciccone, even though the hardware for each platform can be different. Thus, it is clear that Ciccone uses a single file template for each platform, and performs all functionality based on the "unique platform" and not based on the operating system. For example, consider the cited section at col. 12, lines 22-40, where a program sppcheck 40 employs a state list 120 which identifies each object to be checked, and which queries the node based on the state list, as opposed to "determining which of two or more proprietary operating systems is used by the point of sale device" and "transmitting the programming request to the point of sale device *based on the proprietary operating system used by the point of sale device.*" Not only does the cited section make clear that the third element of claim 10 is not disclosed by Ciccone, it also makes clear that state lists 120 for unique platforms are used to determine which objects to check, as opposed to simply determining the operating system.

Claims 14 and 17 are likewise allowable for the reasons discussed above in regards to claim 10, and claim 14 is also allowable for the reason that it depends from an allowable base claim and adds limitations not present in the prior art.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Sandahl. This rejection is respectfully traversed.

Ciccone in view of Sandahl fails to anticipate claims 11 and 12 because they fail to disclose each element of the claimed invention. Consider claim 11, which includes the "method of claim 10 wherein receiving the programming request for the point of sale device comprises receiving a device setup command from the point of sale device." The Examiner's reasons for rejection do not address this limitation; instead, the Examiner states that "Ciccone does not teach the initiation of the device update by the device itself." However, claim 11 does not cover device *update*, it covers device *setup*. While Ciccone does disclose sending update information, it does

ATTORNEY DOCKET NO.
13647.0003

PATENT
Customer ID No. 33649

not disclose setting up a device. Likewise, Sandahl also fails to disclose the device initiating a setup. The functionality required for performing an update is quite different from the functionality for performing a setup. Thus, by the Examiner's own admission, the claimed limitations are missing from Ciccone and Sandahl.

In regards to claim 12, the Examiner 12 states that claims 12 "is an apparatus claim of claim 11." Nevertheless, claim 12 states the "*method of claim 10* wherein receiving the programming request for the point of sale device comprises receiving a device update command from the point of sale device." This is not an apparatus claim depending on claim 11, nor is it an apparatus claim at all. In fact, the difference between claims 11 and 12 is that claim 11 includes "device setup command," and claim 12 includes "device update command." Thus, the Examiner's statement of the reasons for rejection of claim 12 is more properly applied to claim 11, but that still leaves claim 12 without any legitimate basis for rejection. In regards to the Examiner's reason for the rejection of claim 11 as applied to claim 12, see the response to the rejection of claim 10.

Claim 13 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Rogge. Claims 15, 16, 18 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Resende. Claims 19 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone in view of Coutts. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ciccone, presumably in view of Resende (this is not clear in the office action), and presumably further in view of alleged admitted prior art. As these rejections have been traversed other than as to Ciccone in the previous office actions, they will not again be traversed, as responding to the first 6 rejections imposed by the Examiner has taken a significant amount of time, and all of these rejections are based on a combination of Ciccone, which has been traversed, with other prior art that has been traversed in this response (Resende), or in prior office actions (Rogge, Coutts, alleged admitted prior art). As the Applicants have clearly shown that the sections cited by the Examiner as supporting the basis for the rejection of the other claims do not in fact provide such support, the Applicants request the Examiner to review the cited art, in light of Applicant's prior arguments. However, if a final office action subsequently issues improperly on the claims in light of these arguments and amendments

**ATTORNEY DOCKET NO.
13647.0003**

**PATENT
Customer ID No. 33649**

presented herein, then no doubt any further argument as to the remaining claims would also be to no avail, and an appeal will be the only remaining option.

ATTORNEY DOCKET NO.
13647.0003

PATENT
Customer ID No. 33649

CONCLUSION

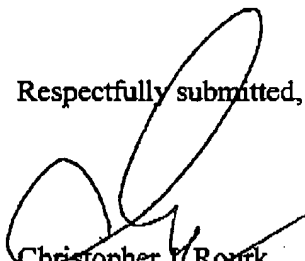
In view of the foregoing remarks and for various other reasons readily apparent, Applicant submits that all of the claims now present are allowable, and withdrawal of the rejection and a Notice of Allowance are courteously solicited.

If any impediment to the allowance of the claims remains after consideration of this amendment, a telephone interview with the Examiner is hereby requested by the undersigned at (214) 939-8657 so that such issues may be resolved as expeditiously as possible.

A fee of \$120 for a one month extension of time is believed to be due at this time, and a petition therefore is hereby made. If any applicable fee or refund has been overlooked, the Commissioner is hereby authorized to charge any fee or credit any refund to the deposit account of Godwin Gruber LLP, No. 500530.

Date: August 2, 2005

Respectfully submitted,



Christopher J. Rourke
Reg. No. 39,348
ATTORNEY FOR APPLICANT

GODWIN GRUBER LLP
1201 Elm Street, Suite 1700
Dallas, TX 75270
Direct: 214-939-8657
Fax: 214-760-7332
Email: crourke@godwingruber.com